

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

Paper No. 25

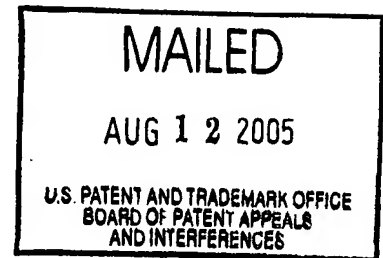
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY H. SCHWAB
and JOHN G. POSA

Appeal No. 2005-1014
Application No. 08/822,397

ON BRIEF



Before: JERRY SMITH, GROSS and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 18 through 40. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to an apparatus for integration of a plurality of television source signals into a single system. The apparatus has provisions to include a broadcast-frequency tuner, a cable tuner and a direct broadcast satellite tuner. Additional inputs are available for other devices such as a VCR. The apparatus provides outputs to the TV in both baseband audio-video and an RF modulator. Through an infra-red remote controller the user can re-assign channel designations and input source switching as part of the channel selection. See page 2 of appellants' specification.

Claims 18 and 26 are representative of the invention and reproduced below:

18. A method of automatically changing to an alternate transmission medium at a TV viewer location, comprising the steps of:
 - entering, at the viewer location, information regarding a viewing preference;
 - transmitting a TV program from a source to a viewer location;
 - receiving the TV program at the viewer location over a first transmission medium; and
 - automatically switching the TV program to the alternate transmission medium based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of the switching.
26. A method of directing an automatic channel changing function at a viewer location to achieve a cohesive viewing environment, comprising the steps of:
 - providing a channel selector at a viewer location; and
 - transmitting, from a broadcaster to the viewing location, a TV program on a primary transmission medium the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more secondary transmission media.

Rejection at Issue

Claims 18 through 40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The examiner's rejection is set forth on pages 4 through 7 of the answer.

Opinion

We have carefully considered the subject matter on appeal and the rejection advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 18 through 25 under 35 U.S.C. § 112. However, we will not sustain the examiner's rejection of claims 26 through 40 under 35 U.S.C. § 112.

Grouping of the claims.

At the outset, we note that appellants state, on page 3 of the brief, that:

All pending claims 18-25 stand or fall with claim 18.

Appellants amend this statement, on page 1 of the reply brief, stating:

In the Examiner's Answer, the Examiner has reformulated the grouping of claims on the grounds that claims 18-25 recite subject matter different from claims 26-40. Accordingly, based upon the Examiner's election, the claims of this application as reciting patentably distinct subject matter for independent review by the Board:

Group 1- Claims 18-25, wherein claims 19-25 stand or fall with claim 18;

Group II- Claims 26-40, wherein claims 27-40 stand or fall with claim 26.

37 C.F.R. § 1.192(c) (7) (July 1, 2003) as amended at 62 Fed. Reg. 53196 (October 10, 1997), which was controlling at the time of appellant filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c) (8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Initially, we note that in the final rejection dated July 30, 2003, claims 18 through 40 are rejected under 35 U.S.C. § 112, and that the statement of the rejection identifies different reasons for rejecting claims 18 through 25 than applied for either claims 26 through 33 and claims 34 through 40. We also note that the appeal brief contained no arguments directed to claims 26 through 40. Though, in this instance we will accept appellants' grouping of the claims and arguments for claims 26 through 40 presented in the reply brief, appellants' counsel is cautioned that in future applications, such an oversight may result in dismissal of the appeal of the claims for which no argument is presented until filing of the reply brief.

Rejection of claims in Group 1 (Claims 18 through 25).

We first consider the rejection of claims 18 through 25 under 35 U.S.C. § 112, first paragraph. When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a different invention than was the original claim, it is proper to inquire whether the newly claimed subject matter was described in the application when filed as the invention of the appellants. *In re Richard Wright*, 866 F.2d 422, 424, 9 USPQ2d 1649, 1651 (Fed. Cir. 1988) (emphasis in original). This is the essence of the description requirement of section 112, first paragraph: whether one skilled in the art, familiar with the practice of the art at the time of the filing date, could reasonably have found the “later” claimed invention in the specification as filed. *See Texas Instruments Inc. v. U.S. International Trade Commission*, 871 F.2d 1054, 1062, 10 USPQ2d 1257, 1262-63 (Fed. Cir. 1989); *Wesphal v. Fawzi*, 666 F.2d 575, 577, 212 USPQ 321, 323 (C.C.P.A. 1981). (Amended claims are reviewed to determine if they are supported in the original disclosure under 35 U.S.C. §112, first paragraph. If the amended claim is not supported in the original specification, the claim will be rejected). The test for compliance with 35 U.S.C. §112 requires that the original disclosure provide sufficient information to show that the inventor possessed the invention at the time of the original filing. *Moba B.V. v Diamond Automation Inc.* 66 USPQ2d 1429, 1439 (Fed. Cir. 2003) (citing *Vas-Cath*, 935 F.2d at 1561) “The possession test requires assessment from the viewpoint of one of skill in the art.” *Id.* “The description

must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *Id.*

Initially, we note that claim 18, was not present in the originally filed application. Appellants have admitted that claim 18 was added to the application by an amendment in September 2000. (See page 1 of the brief). Thus, the test is whether the subject matter in claim 18 was described in the application when filed. We find that it was not.

Appellants argue, on page 3 of the brief,

[A]n important point of novelty of this invention is the ability to integrate and select among channels derived through various transmission media into a cohesive viewing environment. Reference is made to the Summary of the Invention, where it is disclosed that “a system controller, which accepts control signals from a standard infrared-type hand –held remote-controller, handles such tasks as input selection and channel switching, and allows the user to reassign channel designations at will, *even including input switching as part of the channel selection.*” “In a preferred embodiment, the unit may be provided with additional tuner provisions associated with any of the various inputs...” (page 3, lines 3-5). “All of these input sources are demodulated and provided to the audio/video switching matrix as baseband audio and video signals, enabling signal routing within the audio/video switching matrix to be implement a baseband video ‘bus.’” (Specification page 4, lines 16-20.)

Thus, clearly to one of ordinary skill in the art, channels on primary vs. secondary transmission media may be selected at will, without regard to origin. This understanding is corroborated by the claims of this application as *originally filed* on June 8, 1995, a copy of which are attached hereto as Appendix B. Reference is made to original claim 1, which not only discloses the ability to switch between a broadcast-frequency and cable TV program in accordance with viewer preferences, but also the capability of selectively routing a program from any of the associated inputs.

Further, on page 2 of the reply brief, appellants assert:

The step of “automatically switching the TV program to the alternate transmission medium based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of

the switching,” is clearly met by the disclosure of the system controller not only handles such tasks as input selection and channel switching, but even allows “input switching as part of the channel selection.” Thus, to anyone of skill in the art, thus should be interpreted to mean that, based upon information previously entered by a user, when that user picks up the hand-held remote and changes the *channel*, a change of input may also automatically occur; that is, from cable to satellite, from broadcast to cable, and so forth.

In response, the examiner on pages 7 and 8 of the answer agrees with the appellants that the specification discloses a user may select a channel from any of the inputs. The examiner states:

However, the specification does not explicitly state that the invention enables automatic switching of channels from one transmission medium to a different transmission medium without user intervention.

By way of example, on page 5, lines 18-23, the specification states. “a primary channel will typically carry ‘primary’ program information along with additional information used by the system for directing a second tuner to a second channel.” Notwithstanding this teaching, there is no disclosure that explicitly teaches that the additional information may be used to automatically switch the system, for instance, from the cable source to the satellite source or broadcast source, or vice versa.

Further, on pages 8 and 9 of the answer, the examiner analyzes the difference in scope of originally filed claim 1 and appealed claim 18.

We concur with the appellants and find that the that the originally filed specification teaches that “when that user picks up the hand-held remote and changes the *channel*, a change of input may also automatically occur; that is from cable to satellite, from broadcast to cable, and so forth” as argued by appellants. However, appellants’ claim 18 is not commensurate in scope with these teachings of the originally filed specification. Claim 18 includes limitations

“transmitting a TV program”, “receiving the TV program at the viewer location over a first transmission medium” and “ automatically switching the TV program to the alternate transmission medium.” As all of these limitations refer to “the TV Program” we consider the scope of the claim as limited to the TV program being available over a first transmission medium and second transmission medium. Thus, appellants’ arguments are not directly applicable as the claim is directed to changing the transmission medium for the same TV program, not changing the transmission medium as the user changes channels.

We concur with the examiner and find that on pages 5 and 6 of appellants’ originally specification there is a teaching that a program may be on a primary channel and a secondary channel. And as discussed *infra* with respect to claims 26 through 40, we find that appellants’ originally filed specification does teach that the two channels can be on different transmission media. However, appellants’ have not asserted, nor do we find, that the switching of transmission media, as taught in pages 5 and 6 of appellants’ originally filed specification, is performed based upon information, regarding a viewing preference, previously entered by the viewer, as is claimed in claim 18.

Further, we find that originally filed claim 1 does not provide support for appealed independent claim 18. We concur with the examiner’s statement, on page 9 of the answer:

[w]hile original claim 1 does recite, “selectively route a TV program from any of the various inputs”, the instant claim does not state that the instant TV program is subsequently routed to or through a different input or transmission medium. Instead, original claim 1 recites that the instant TV program is routed “to the output for viewing on the display device”.

Furthermore, even though the claim recites, “the switching of a particular input being a function of the user-defined channel designations”, there is no specific recitation as to how the selective routing of the TV program relates to the switching of a particular input. And certainly there is no explicit recitation that states a TV program on a first transmission medium is switched (e.g., selectively routed) to a second transmission [medium], different from the first transmission medium.

Accordingly, we sustain the examiner’s rejection of claims 18 through 25 under 35 U.S.C. § 112, first paragraph.

Rejection of claim in Group 2 (Claims 26 through 40).

On page 5 of the answer, regarding the rejection of claim 26, the examiner states “[c]onsidering claim 26, the recited feature calls for, ‘transmitting, from a broadcaster to a viewing location, a TV program on a primary transmission medium, the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more secondary transmission media’, which is not found in the specification.” The examiner applies similar rationale in rejecting claim 34.

On pages 2 and 3 of the reply brief, appellants assert that claims 26 through 40 are supported by the originally filed specification. Appellants refer to the disclosure on page 5 of the original specification which discusses an embodiment where “a primary channel will typically carry ‘primary’ program information along with additional information used by the system for directing a second tuner to a secondary channel” and figure 1 which depicts different tuners being for different transmission media, as providing support for this limitation.

We concur with the appellants. We find that appellants' originally filed specification, on page 5, discloses an embodiment where two channels on different media are used to transmit a television program. Further, we find page 6 of appellants' originally filed specification discloses a " 'channel-hopping' scheme may be used, wherein different related channels are used at different times, with only authorized viewers being provided with the overall plan." We find that from these two disclosures, in the appellants' originally filed specification, one skilled in the art, familiar with the practice of the art at the time of the filing date, could reasonably have found the limitation of "transmitting, from a broadcaster to the viewing location, a TV program on a primary transmission medium, the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more secondary transmission media" as currently claimed in claim 26. Claim 34 contains a similar limitation. Accordingly, we will not sustain the examiner's rejection of claims 26 through 40 under 35 U.S.C. § 112.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellant (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger* 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit Court stated that because the appellant did not contest the merits of the

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rejections in his brief to the Federal Circuit Court, the issue is waived. **See also**
In re Watts 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In summary, we sustain the examiner's rejections of claims 18 through 25 under 35 U.S.C. § 112. However we will not sustain the examiner's rejection of claims 26 through 40 under 35 U.S.C. § 112. The decision of the examiner is affirmed-in-part.

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